

## **REMARKS**

### **Election Requirement**

The Examiner has required an election between Figure 1 and Figure 4. During a telephone conversation with the Examiner, Applicant's attorney provisionally elected Figure 1, and discussed that claims 1-10, 14, 16, 18, 23-40 read upon it. Applicant hereby affirms this provisional election and elects to proceed with claims 1-10, 14, 16, 18, 23-40 for continued examination. Claims 11-13, 15, 17, and 19-22 have been withdrawn by the Examiner as being drawn to a non-elected species.

Accordingly claims 1-10, 14, 16, 18, 23-40 are hereby pending for consideration in this application with claims 1, 9, 14, 16, 23, 27, 31, and 35 being independent. Applicant hereby amends claims 1, 3-6, 8-9, 14, 16, 18, 23-31, 35, 38-40. No new matter has been added.

### **REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103**

Claims 1-6, 8-10, 14-16, 23-25, 27-33, 35, 36, and 38-40 stand rejected under 35 U.S.C. § 102(e) as purportedly being unpatentable over Kahn, et al. (U.S. Patent No. 6,853,728). Claim 7 stands rejected under 35 U.S.C. § 103(a) as purported being unpatentable over Kahn in view of Towell, et al. (U.S. Patent No. 6,647,411). Claim 18 stands rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Kahn in view of Novak (U.S. Pub. No. US 2002/0104099 A1). Claims 26 and 34 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Kahn in view of Rosengren, et al. (U.S. Patent No. 6,741,617). Claim 37 stands rejected under 35 U.S.C. § 103(a) as being as purportedly being unpatentable over Kahn in view of Nations, et al. (U.S. Patent No. 6,870,808). Applicant respectfully disagrees and traverses as follows.

#### **Claims 1-8**

Claim 1 is directed to a system for ensuring the recording of purchased programming that includes determining whether a user has the ability to *record* rather than simply *watch* the selected programming. The Examiner cites column 7, lines 62-67 of Kahn for support that Kahn teaches "canceling the order if it is not verified that the recording device is programmed to record the

programming.” (Office Action at 4). In citing that particular section of Kahn, the Examiner states, “Note: confirming the right to purchase is interpreted as being equivalent to canceling the order when the device is not verified.” (Office Action at 4). However, the section cited by Kahn only teaches confirmation of the right to purchase a program for *viewing*. However, this is not equivalent to canceling an order when a device is incapable of *recording* a program.

As is known in the art, a user may indicate his or her desire to purchase a pay-per-view or other program which may result in that user’s set top box or other device being verified to receive the selected purchased programming. However, if the user wishes to record the selected purchased programming (as opposed to simply watching the selected purchased programming when it is delivered) a user recording device must be capable of recording the selected purchased programming. As indicated in the specification of the application on page 7, lines 14-25, there are a number of problems that may occur with a recording device that would render it incapable of recording selected purchased programming. Examples include a digital recorder being out of storage space, a video tape recorder lacking a video tape, a communication problem with the recording device, etc. Any of these problems may lead to a user purchasing a particular piece of programming, but being unable to record it (and eventually watch it), thereby resulting in a wasted order.

Claim 1 requires, “the recording device controller canceling the order if it is not verified that the recording device is programmed to record the programming.” This ability to cancel the recording allows for more efficient transfer of purchased programming to a user. Without the ability to cancel the programming, a user may pay for a particular program but will be unable to watch it because the recording device may not be programmed to record the programming. In this situation, the user may have the right to purchase the programming (and may actually purchase it), but the programming will not be recorded and will be lost. Thus, a conventional system can confirm the right of a user to purchase a program without actually canceling the order if the programming device is not programmed to record the programming.

The section of Kahn cited by the Examiner, and indeed the remainder of Kahn, does not teach, disclose or suggest canceling an order for purchased programming if a recording device is not programmed to record the purchased programming. Indeed, nowhere does Kahn discuss problems

that may occur if a recording device is incapable of recording the purchased programming. Kahn is therefore not directed to solving that problem.

As Kahn does not teach, disclose or suggest canceling the order if it is not verified that the recording device is programmed to record the programming, Kahn does not teach, disclose or suggest all of the limitations of claim 1. Claim 1, therefore, is patentable over Kahn. As claims 2-6 and claim 8 depend from claim 1, they are patentable over Kahn for at least the reasons discussed above in reference to claim 1. Claim 7 also depends from claim 1 and is patentable for at least the same reasons discussed above as the combination of Kahn and Towell does not teach, disclose or suggest all the limitations of claim 1.

#### Claims 9-10

Claim 9 has been amended to include the limitation: "if the user recording device is unable to record the program, the order processor cancels the order." As should be appreciated from the discussion above in reference to claim 1, Kahn does not teach, disclose or suggest canceling an order if a user recording device is unable to record a program. Claim 9 is therefore patentable over Kahn for at least this reason. Claim 10 depends from claim 9 and is patentable over Kahn for at least the same reasons.

#### Claim 14

Claim 14 has been amended to include the limitation: "if the order processor is unable to confirm the ability of the user recording device to record the program, canceling the order for the programming." As should be appreciated from the foregoing, Kahn does not teach, disclose or suggest canceling an order if an order processor is unable to confirm the ability of a user recording device to record a programming. Claim 14 is therefore patentable over Kahn for at least this reason.

#### Claims 16 and 18

Claim 16 has been amended to include the limitation of the user recording device executing instructions to: "communicate an ability or inability to record a program." As should be appreciated from the foregoing, Kahn does not teach, disclose or suggest the user recording device executing

instructions to communicate an ability or inability to record a program. Claim 16 is therefore patentable over Kahn for at least this reason. Claim 18 depends from claim 16 and is patentable for at least the same reasons discussed above as the combination of Kahn and Novak does not teach, disclose or suggest all the limitations of claim 16.

#### Claim 23-26

Claim 23 has been amended to include, “communicating instructions with the recording device, and, if the recording device is able to record the selected programming” sending selected programming and instructing the recording device to record the selected programming. As should be appreciated from the foregoing, Kahn does not teach, disclose or suggest sending selected programming if a recording device is able to record the selected programming. Claim 23 is therefore patentable over Kahn for at least this reason. Claims 24 and 25 depend from claim 23 and are patentable for at least the same reasons. Claim 26 also depends from claim 23 and is patentable for at least the same reasons discussed above as the combination of Kahn and Rosengren does not teach, disclose or suggest all the limitations of claim 23.

#### Claims 27-30

Claim 27 has been amended to include, “if the recording device is not programmed to record the selected programming, canceling the order.” As should be appreciated from the foregoing, Kahn does not teach, disclose or suggest this limitation. Claim 27 is therefore patentable over Kahn for at least this reason. Claims 28-30 depend from claim 27 and are patentable for at least the same reasons.

#### Claims 31-34

Claim 31 is directed to a system for recording purchased programming comprising a recording device which performs actions comprising: “verifying to the program delivery mechanism that the recording device is programmed to record a particular purchased program.” As discussed above in reference to claim 1, verifying that a recording device is programmed to record a particular purchased program is not the same as confirming that the user has a right to purchase a program. In

citing Kahn against claim 31, the Examiner cites 7, lines 62-67 as purportedly disclosing this type of verifying. (Office Action at 8). However, as discussed above in reference to claim 1, this section of Kahn teaches only confirmation of the right to purchase a program and does not teach, disclose or suggest verifying that a recording device is programmed to record a particular purchased program. Indeed, nowhere does Kahn teach, disclose or suggest verifying that a recording device is programmed to record a particular purchased program. Because Kahn does not teach, disclose or suggest all the limitations of claim 31, claim 31 is patentable over Kahn. Claims 32 and 33 depend from claim 31 and are patentable for at least the same reasons. Claim 34 also depends from claim 31 and is patentable for at least the same reasons discussed above as the combination of Kahn and Rosengren does not teach, disclose or suggest all the limitations of claim 31.

#### Claims 35-40

Claim 35 requires: "if it is not verified that the recording device is programmed to record the programming either: canceling the order, attempting to reschedule the order, or notifying the entity which placed the order." As discussed above, Kahn does not teach, disclose or suggest canceling an order if it is not verified that a recording device is not programmed to record the programming. In rejecting this claim, the Examiner relies on the same section of Kahn cited against claim 1, namely column 7, lines 62-67. (Office Action at 8). As discussed above in reference to claim 1, neither this section nor any other section of Kahn teaches, discloses or suggests canceling an order if it is not verified that a recording device is not programmed to record the programming. Similarly, nowhere does Kahn teach, disclose or suggest attempting to reschedule an order, or notifying an entity which placed an order, if it is not verified that the recording device is programmed to record the programming.

Because Kahn does not teach, disclose or suggest all the limitations of claim 35, claim 35 is patentable over Kahn. Claims 36 and 38-40 depend from claim 35 and are patentable for at least the same reasons. Claim 37 also depends from claim 35 and is patentable for at least the same reasons discussed above as the combination of Kahn and Nations does not teach, disclose or suggest all the limitations of claim 35.

**CONCLUSION**

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance.

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: September 28, 2006

Respectfully submitted,

By 

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